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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/789,305 | 02/27/2004 | Morgan T. Johnson | ML. P004 | 9203 |
| 41536 | 7590 | 04/17/2006 | EXAMINER KARLSEN, ERNEST F | |
| RAYMOND J. WERNER 2056 NW ALOCLEK DRIVE, SUITE 314 HILLSBORO, OR 97124 | | | ART UNIT 2829 | PAPER NUMBER |

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,305

Applicant(s)

JOHNSON, MORGAN T.

Examiner

Ernest F. Karlsen

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claims 1-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 26, 2005.

The requirement to elect of December 13, 2005 is withdrawn and claims 12-20 acted on.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Leas et al. With regard to claims 12-18, Leas et al show a product wafer 18 and a full wafer contactor 16 which faces the wafer 18 wherein contact is made by drawing a vacuum between elements 16 and 18. See column 3, lines 45 plus; column 7, lines 42 plus; column 8, lines

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13 plus; column 13, lines 42 plus and column 15, line 44 through column 16, line 23.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kwon et al. With regard to claims 12 and 19, Kwon et al show a wafer 10 and a wafer contactor comprised of the parts of element 14 minus elements 36 and 38. Note that contacts 30 and 18 have different pitches.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter

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pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kwon et al in view of Rostoker et al. Kwon et al show that claimed except for the testing of die of different sizes. Rostoker et al show the testing of die of different sizes. See column 4, lines 52 plus. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adapted the apparatus of Kwon et al to test die of different sizes as taught by Rostoker et al because one of ordinary skill in the art would realize that so doing would enable testing of a greater variety of devices.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamada et al, DeHaven et al, Illani, Yojima et al and Burns are cited to show apparatus and method similar to that of Leas et al and Kwon et al.

Any inquiry concerning this communication should be directed to Ernest F. Karlsen at telephone number 571-272-1961.

Ernest F. Karlsen

April 10, 2006


ERNEST KARLSEN
PRIMARY EXAMINER